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TTAB

CERTIFICATE OF TRANSMISSION
UNDER 37 C.F.R. § 1.8



05-21-1999

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Date of Mailing, First Class Mail, May 18, 1999. ¹⁵ _{ml}

I hereby certify that this paper or fee is being deposited with the United States Postal Service, First Class mail, postage prepaid, on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington VA 22202-3513.


Michael Krinsky

IN THE PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

GALLEON, S.A., et al.

Petitioners,

v.

Cancellation No. 24,108

HAVANA CLUB HOLDING, S.A., dba HCH, S.A.

Respondent.

Attention: Carmen C. Ruth
Paralegal, Trademark Trial and Appeal Board

RESPONDENT'S RESPONSE TO STATUS INQUIRY

Havana Club Holding, S.A. hereby responds to the TTAB's request sent of 23, 1999, asking for information on "the status of the civil action which occasioned the suspension of this proceeding."

On April 19, 1999, the District Court entered a judgment in *Havana Club Holding, S.A. v. Galleon S.A.*, No. 96 Civ. 9655 (SAS) (S.D.N.Y.), dismissing plaintiffs' claims. Plaintiffs' post-trial

motions for amended findings, pursuant to Rule 52, Fed. R. Civ. P., and for an injunction pending appeal, pursuant to Rule 62, Fed. R. Civ. P., are presently pending. As soon as the former motion is decided, plaintiffs will promptly file a notice of appeal covering the final judgment and the previous partial judgment (see below) and opinions entered in the case (a notice of appeal which would be ineffective if it were filed while that motion is pending. See Rule 4(a)(4), F. R. App. P.).

The TTAB's suspension of the cancellation proceeding should continue until the Second Circuit resolves plaintiffs' forthcoming appeal, because the district court expressly decided that the Partial Judgment entered October 20, 1997, which underlies Galleon's petition and which directed (a) that Havana Club Holding has no rights in or claims to U.S. Reg. 1,031,651, but (b) that nothing in that Partial Judgment would "prevent Cubaexport, if it so chooses, from asserting or seeking to enforce rights in the trademark HAVANA CLUB rum in the United States," should not become effective until any appeals from that Judgment were decided. In its last paragraph, the Partial Judgment, a copy of which is attached, expressly provides that it would be stayed pending appeal to the Second Circuit (emphasis added):

The operation and enforcement of this Judgment, including modification of or entry upon the records of the United States Patent and Trademark Office pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119, are stayed pending appeal from the final judgment in this action.

The notice of appeal will appeal, *inter alia*, from that Partial Judgment and the Opinion and Order of August 8, 1997, 974 F. Supp. 302 (1997), which it effectuates.

Since the district court's decision concerning Havana Club Holding's rights in the specified registration is subject to appeal, and may be reversed, judicial economy, fairness, and respect for the

district court's own stay require that the TTAB stay its hand on this issue pending the Second Circuit's disposition of the appeal.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael Krinsky', is written over a horizontal line.

MICHAEL KRINSKY (MK 4503)
RABINOWITZ, BOUDIN, STANDARD,
KRINSKY & LIEBERMAN, P.C.
740 Broadway - Fifth Floor
New York, New York 10003
(212) 254-1111

57

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

OCT 20 1997

HAVANA CLUB HOLDING, S.A. and
HAVANA CLUB INTERNATIONAL, S.A.,

Plaintiffs,

- against -

GALLEON S.A., BACARDI-MARTINI USA,
INC., GALLO WINE DISTRIBUTORS,
INC., G.W.D. HOLDINGS, INC.
and PREMIER WINE AND SPIRITS,

Defendants.

96 Civ. 9655 (SAS)

PARTIAL JUDGMENT

WHEREAS, the Plaintiffs initiated this action alleging, inter alia, infringement of the registered mark HAVANA CLUB for rum; and

WHEREAS, this Court issued its opinion dated August 8, 1997, in connection with certain motions therein;

NOW, THEREFORE, IT IS ORDERED, ADJUDGED AND DECREED:

1. The Cuban Asset Control Regulations ("CACR") implemented in 1963 under Section 5(b) of the Trading With The Enemy Act of 1917, as amended, 50 U.S.C. App. 1-44, prohibit transfers of property, including trademarks, in which a Cuban entity has an interest except when authorized by the Office of Foreign Assets Control ("OFAC") acting on behalf of the Secretary of the Treasury.

2. In 1976, the trademark HAVANA CLUB for "rum" was registered in the United States Patent and Trademark Office ("related U.S. Registration") by Empresa Exportadora de Alimentos y Productos Varios ("Cubaexport"), a Cuban state enterprise.

3. On October 29, 1993, Cubaexport entered into an agreement transferring the U.S. rights to the HAVANA CLUB trademark and the related U.S. Registration to Havana Rum & Liquors, S.A. On or about November 22, 1993, Havana Rum & Liquors, S.A. entered into an agreement transferring the aforesaid mark and the related U.S. Registration to Havana Club Holding, S.A.

4. Those provisions of the original transfer agreement relating to transfers of the U.S. rights to the HAVANA CLUB mark and the related U.S. Registration were rendered null and void by the CACR, § 515.201(b)(1), and the attempted assignment of said HAVANA CLUB mark and the related U.S. Registration were invalid and of no force and effect and void ab initio.

5. As a result, the status quo ante as of the October 29, 1993 date of said abortive original transfer agreement is restored, and Cubaexport retained whatever rights it had in said mark and the related U.S. Registration as of said date, notwithstanding the invalid transfers.

6. Neither Havana Rum & Liquors, S.A., Havana Club Holding, S.A. nor its licensee, Havana Club International, S.A. ever obtained any rights to the HAVANA CLUB mark in the United States by transfer.

7. Plaintiffs Havana Club Holding, S.A. and Havana Club International, S.A. have no rights to the registered trademark HAVANA CLUB for "rum" in the United States.

8. Any rights that Havana Club Holding, S.A. may have had, may have or claims to have had in the Registration of the HAVANA CLUB trademark (U.S. Reg. No. 1,031,651) from

forever until today are hereby canceled.

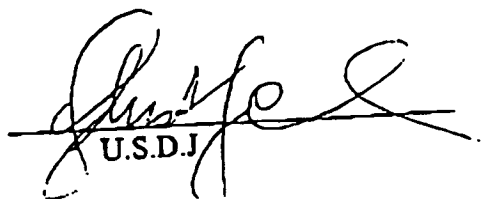
9. Count I for infringement of a federally registered trademark under Section 32 of the Lanham Act is dismissed with prejudice.

10. Nothing herein shall prevent Cubaexport, if it so chooses, from asserting or seeking to enforce rights in the trademark HAVANA CLUB rum in the United States and nothing herein shall prevent the defendants or others from contesting those rights or contending that said rights were lost as a result of acts or omissions by Cubaexport.

11. The Court certifies the instant Order and its Opinion and Order dated August 8, 1997 to the Commissioner of Patents and Trademarks pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119.

12. The operation and enforcement of this Judgment, including modification of or entry upon the records of the United States Patent and Trademark Office pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119, are stayed pending appeal from the final judgment in this action.

Dated at New York, New York, this 20 day of ~~may~~ October, 1997.


U.S.D.J.

IN THE PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

GALLEON, S.A., et al.,
Petitioners,

Cancellation No. 24,108

v.

DECLARATION OF SERVICE
BY MAIL

HAVANA CLUB HOLDING, S.A., dba HCH, S.A.
Respondent.

I, ANDRÉ MOORE, declare under penalty of perjury under the laws of the United States of America that the following is true and correct:

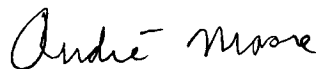
1. I am employed by Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C., I am not a party to this action, I am over eighteen years of age, and I reside in New York, New York; and

2. On the 19th day of May, 1999, I served the annexed Respondents' Response to Status Inquiry upon:

William R. Golden, Jr.
Kelley Drye & Warren LLP
101 Park Avenue
New York, NY 10178

by depositing a true and correct copy of the document with the United States Postal Service, First Class mail, postage prepaid, on the date indicated above and addressed as indicated above.

Executed this 19th day of May, 1999 in New York City, New York.



ANDRÉ MOORE